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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,970	09/07/2006	Eckhard Walters	853563.430USPC	4924
38106 7590 03/12/2009 SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVENUE, SUITE 5400 SEATTLE, WA 98104-7092				
EXAMINER				
NGUYEN, DUC M				
ART UNIT		PAPER NUMBER		
2618				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/591,970

Applicant(s)

WALTERS ET AL.

Examiner

DUC M. NGUYEN

Art Unit

2618

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-14 is/are allowed.
- 6) ☒ Claim(s) 16-18 is/are rejected.
- 7) ☒ Claim(s) 1-9, 15, 19-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-856)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

This action is in response to applicant's response filed on 12/23/08. Claims 1-20 are now pending in the present application. **This action is made final.**

Claim Objections

1. Claims **1-9, 16-20** are objected to because of the following informalities:

- As to claims **1, 16**, the "is operatively functional" as recited in the claims should be changed to "**is calibrated** (or tested) to be operatively functional" for clarification purpose.

- As to claim **1**, the limitation "that is exterior to the SIM card" should be deleted because

a- it is not clear whether the "second memory" or the "individual mobile terminal specific data" is external to the SIM card.

b- if the "second memory" is external to the SIM card, this would contradict the limitation "SIM card including a second memory".

c- if the "individual mobile terminal specific data" is external to the SIM card (data), it would not necessary to recite such limitation because the "individual mobile terminal specific data" includes "calibration values" which would implicitly exterior (or unrelated) to the "SIM card data". Note here, "SIM card **data**", not "SIM card".

Therefore, the limitation "that is exterior to the SIM card" would make confusions and should be deleted.

As to claim **2**, insert a period (".") at the end of the paragraph.

As to claims **15, 18**, “no other memory” should be changed to “no other non-volatile memory” because Fig. 2 clearly shows a RAM memory 8.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 18 recites the limitation “the mobile terminal includes the first memory device and the second memory device and no other memory device”. However, Fig. 2 clearly shows a RAM memory 8. Therefore, the claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim Rejections - 35 USC 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **16-18** are rejected under 35 U.S.C. 103(a) as being unpatentable by Applicant's admitted prior art (Fig. 1 and [0026]), hereafter **AAPA**.

Regarding claim **16**, **AAPA** would teach a mobile terminal comprising:

a first processing unit (see Fig. 1, ref. 6 or 7);

a first memory device that is one of a read only memory (ROM) or as a Flash memory and that has terminal independent data including at least an operation system and start-up sequences stored therein, wherein terminal independent data are stored therein during manufacturing of the mobile terminal, and wherein the first memory device is electrically connected to the first processing unit (see Fig. 1, refs. 10, 14 and [0026]), wherein the "operating system or application software" would read on the claimed "terminal independent data". Further, it would have been obvious to combine the boot ROM 10 and Flash/ROM 14 because it has been held that forming in one piece an article which has formally been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).; and

a SIM card chip that is communicatively coupled to the first processing unit and that includes a second memory device, the second memory device is reprogrammable and has individual mobile terminal specific data stored therein (see 0026), wherein "network setting, phone number or user setting individual mobile terminal specific data"

would read on the claimed "individual mobile terminal specific data", wherein individual mobile terminal specific data are stored in the second memory device after the mobile terminal is operatively functional (see [0026] regarding "user settings" which would obviously, if not implicitly, stored after the phone is activated for operatively functional and is set by a user).

Therefore, the claimed limitations are made obvious by AAPA.

Regarding claim 17, the claim is rejected for the same reason as set forth in claim 16 above. In addition, **AAPA** as modified would teach the first memory has application software, fixed data, and security settings stored therein, and wherein the mobile terminal is fully functionally operable in a post manufacturing state with only the first memory device and the second memory and does not require any other memory device to fully operate after manufacturing (see [0026] regarding refs. 10, 14, 13), noting that no other memory device is required to fully operate after manufacturing.

Regarding claim 18, the claim is rejected for the same reason as set forth in claim 16 above. In addition, **AAPA** as modified would teach the mobile terminal includes the first memory device and the second memory device and no other non-volatile memory device (see Fig. 1 and [0026]).

Allowable Subject Matter

6. Claims 1-9 would be allowable if rewritten or amended to overcome objections and/or the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

7. Claim 15 would be allowable if rewritten to overcome the objection set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
8. Claims 19-20 would be allowable if rewritten to overcome the objections and/or rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
9. Claims 10-14 are allowed.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

See the attached PTO-892.

12. **Any response to this final action should be mailed to:**

Box A.F.

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for **formal** communications intended for entry)

(571)-273-7893 (for informal or **draft** communications).

Hand-delivered responses should be brought to Customer Service Window,
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

Any inquiry concerning this communication or communications from the examiner
should be directed to Duc M. Nguyen whose telephone number is (571) 272-7893,
Monday-Thursday (9:00 AM - 5:00 PM).

Or to Nay Maung (Supervisor) whose telephone number is (571) 272-7882.

/Duc M. Nguyen/

Primary Examiner, Art Unit 2618

Mar 10, 2009